

REMARKS

Claims 2-27 and 29-56 are pending. Claims 7 and 34 were amended as discussed below.

No new matter was added. The new phrase is clearly supported by the entirety of the specification and figures (e.g., Fig. 1) which describe and illustrate that the step of selecting one of the groups of network configuration settings 135 for the user's client machine 120 from the defined groups of settings is initiated on the user's client machine 120 and not on the network used for the network connection 150 established between the user's client machine 120 and the remote server 105. Furthermore, the new phrase is fully compliant with the guidelines set forth in MPEP 2173.05(i) regarding "negative limitations," attached hereto as Appendix A.

Withdrawal of all outstanding objections and rejections is respectfully requested for at least the reasons set forth below.

Examiner Interview

Applicants wish to thank Examiner Gold for extending the courtesy of a personal interview with Applicants' undersigned representative on January 8, 2009. During the interview, the contents of the previously filed Response was discussed. The following specific items were discussed:

1. Applicants' undersigned representative emphasized that Claessens discloses a system and method for network performance testing which has nothing to do with the claimed invention which relates to optimizing network configuration settings for a user's client machine, not a network, by adjusting network configuration settings of the user's client machine.

2. The Examiner pointed out that the "plurality of groups of network configuration settings for the user's client machine" in claims 7 and 34 could potentially be met by the network-related parameters in Claessens because one way to read this clause is that a client machine merely has to be connected to a network, wherein a plurality of groups of network-related parameters are used for configuring the network, as disclosed in Claessens. The Examiner suggested that additional clarifying language to highlight the differences would advance prosecution of the application.

3. Although Applicants respectfully disagree with the Examiner's potential reading of Claessens, to advance prosecution of the application and more clearly distinguish the claims

from Claessens, claims 7 and 34 were amended to explicitly recite that the step of selecting one of the groups of network configuration settings for the user's client machine from the defined groups of settings is "initiated on the user's client machine and not on the network used for the network connection established between the user's client machine and the remote server." In contrast to the amended claimed invention, Claessens initiates selection of, and changes to, network-related parameters on the network, and not on any client machine connected to the network.

5. The Examiner agreed to reevaluate the prior art rejection in view of this amendment and the arguments in the previously submitted Response.

6. The Examiner further raised the issue of whether claim 34 meets the requirements of 35 U.S.C. § 101. Applicants' undersigned representative pointed out that this claim is believed to be fully compliant with the statutory requirements of § 101. The claim format of claim 34 is explicitly permitted by the USPTO and should be treated as a statutory product claim, as discussed in MPEP 2106.01, enclosed as Appendix B to this paper, and in *Ex parte Bo Li*, Appeal 2008-1213 (USPTO BPAI 2008, November 6, 2008), enclosed as Appendix C to this paper. See, especially, page 9 of this opinion.

7. Applicants also note that the Interview Summary (PTOL-413) related to the January 8, 2008 interview states that claims 13 and 40 were discussed. Applicants further point out that independent claims 7 and 34 were discussed, as highlighted above.

8. Applicants wish to clarify one statement made in the previously filed Response, which upon further review, could be deemed to be misleading or inaccurate. In the previously filed Response, it was stated on page 12 that "[w]hile a user's client machine communicates with other devices via a network, such as shown in Fig. 1 (see network connection 150), the claimed invention does not test or affect any network parameters. In fact, due to the inherent design of the Internet, certain changes to the network configuration settings of a specific user's client machine inherently affect how data is transmitted across a network to and from the specific user's client machine. This clarification does not in any way detract from the amendments made herein to further distinguish the claims from Claessens.

Conclusion


Insofar as the Examiner's rejections were fully addressed, the instant application is in condition for allowance. Withdrawal of the outstanding rejection and issuance of a Notice of Allowability of all pending claims is therefore earnestly solicited.

Respectfully submitted,

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(Date)

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Enclosure: Appendix A (1 page)
Appendix B (2 pages)
Appendix C (12 pages)

piece”; and “iron, steel or any other magnetic material.”

III. “OPTIONALLY”

An alternative format which requires some analysis before concluding whether or not the language is indefinite involves the use of the term “optionally.” In *Ex parte Cordova*, 10 USPQ2d 1949 (Bd. Pat. App. & Inter. 1989) the language “containing A, B, and optionally C” was considered acceptable alternative language because there was no ambiguity as to which alternatives are covered by the claim. A similar holding was reached with regard to the term “optionally” in *Ex parte Wu*, 10 USPQ2d 2031 (Bd. Pat. App. & Inter. 1989). In the instance where the list of potential alternatives can vary and ambiguity arises, then it is proper to make a rejection under 35 U.S.C. 112, second paragraph, and explain why there is confusion.



2173.05(i) Negative Limitations

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation “R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl” was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).

A claim which recited the limitation “said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber” in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation “incapable of forming a dye with said oxidized developing agent” was definite because the boundaries of

the patent protection sought were clear. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

2173.05(j) Old Combination [R-6]

A CLAIM SHOULD NOT BE REJECTED ON THE GROUND OF OLD COMBINATION

With the passage of the 1952 Patent Act, the courts and the Board have taken the view that a rejection based on the principle of old combination is NO LONGER VALID. Claims should be considered proper so long as they comply with the provisions of 35 U.S.C. 112, second paragraph.

A rejection on the basis of old combination was based on the principle applied in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 37 USPQ 1 (1938). The principle was that an inventor who made an improvement or contribution to but one element of a generally old combination, should not be able to obtain a patent on the entire combination including the new and improved element. A rejection required the citation of a single reference which broadly disclosed a combination of the claimed elements functionally cooperating in substantially the same manner to produce substantially the same results as that of the claimed combination. The case of *In re*

I. FUNCTIONAL DESCRIPTIVE MATERIAL: “DATA STRUCTURES” REPRESENTING DESCRIPTIVE MATERIAL *PER SE* OR COMPUTER PROGRAMS REPRESENTING COMPUTER LISTINGS *PER SE*

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material *per se* from claims that define statutory inventions.

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer

executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program’s functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program’s instructions, USPTO personnel should treat the claim as a process claim. ** When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim. **

II. NONFUNCTIONAL DESCRIPTIVE MATERIAL

Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture, or composition of matter and should be rejected under 35 U.S.C. 101. Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. USPTO personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping or sequence of musical notes read from memory and thereafter causes another defined series of notes to be played, requires a functional interrelationship among that data and the computing processes performed when utilizing that data. As such, a claim to that computer is statutory subject matter because it implements a statutory process.

2106.01 Computer-Related Nonstatutory Subject Matter [R-6]

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and *In re Warmerdam*, 33 F.3d 1354, 1360-61, 31 USPQ2d 1754, 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory).

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable

medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diamond v. Diehr*, 450 U.S. 175, 185-86, 209 USPQ 1, 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. 101. In addition, USPTO personnel should inquire whether there should be a rejection under 35 U.S.C. 102 or 103. USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). USPTO personnel may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384, 217 USPQ at 403; see also *Diehr*, 450 U.S. at 191, 209 USPQ at 10. However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *Lowry*, 32 F.3d 1583-84, 32 USPQ2d 1035; *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

APPENDIX C
(attached to Supplemental Response
for Application No. 10/078,815)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BO LI

Appeal 2008-1213
Application 10/463,287¹
Technology Center 2100

Decided: November 6, 2008

Before: JAY P. LUCAS, ST. JOHN COURTENAY III,
and CAROLY D. THOMAS, *Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

¹ Application filed June 17, 2003. Appellant claims the benefit under 35 U.S.C. § 119 of Korean application 02-1-22649.0, filed 06/18/2002. The real party in interest is International Business Machines Corporation.

Appellant appeals from a final rejection of claims 22 to 42 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b). Claims 1 to 21 are canceled.

Appellant's invention relates to a method and system for generating a report using software modules adapted for easy modification and updating (Spec, p. 1, bottom). In the words of the Appellant:

Custom business reports for a WEB application are generated by parsing a configuration file, processing data logic, and organizing data. The result of the parsed configuration file is further processed by the data logic processing. The data logic processing prepares the data to generated languages suitable for a data query from a database or for locating files. The data is then organized into a form suitable for display.
(Spec, p. 28)

Claim 32 and Claim 42 are exemplary:

32. A method for generating a report, said method comprising:
providing a system, wherein the system comprise distinct software modules embodied on a computer-readable medium, and wherein the distinct software modules comprise a logic processing module, a configuration fill processing module, a data organization module, and a data display organization module;

parsing a configuration file into definition data that specifies: a data organization of the report, a display organization of the report, and at least one data source comprising report data to be used for generating the report, and wherein said parsing is performed by the configuration file processing module in response to being called by the logic processing module;

extracting the report data from the at least one data source, wherein said extracting is performed by the data organization module in response to being called by the logic processing module;

receiving, by the logic processing module, the definition data from the configuration file processing module and the extracted report data from the data organization module;

organizing, by the data display organization module in response to being called by the logic processing module, a data display organization of the report, wherein said organizing comprises utilizing the definition data received by the logic processing module and the extracted report data received by the logic processing module; and

storing the data display organization of the report in a database.

42. A computer program product, comprising a computer usable medium having a computer readable program code embodied therein, said computer readable program code adapted to be executed to implement a method for generating a report, said method comprising:

providing a system, wherein the system comprises distinct software modules, and wherein the distinct software modules comprise a logic processing module, a configuration file processing module, a data organization module, and a data display organization module;

parsing a configuration file into definition data that specifies: a data organization of the report, a display organization of the report, and at least one data source comprising report data to be used for generating the report, and wherein said parsing is performed by the configuration file processing module in response to being called by the logic processing module;

extracting the report data from the at least one data source, wherein said extracting is performed by the data organization module in response to being called by the logic processing module;

receiving, by the logic processing module, the definition data from the configuration file processing module and the extracted report data from the data organization module; and

organizing, by the data display organization module in response to being called by the logic processing module, a data display organization of the report, wherein said organizing comprises utilizing the definition data received by the logic processing module and the extracted report data received by the logic processing module.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Shaughnessy

US 7,015,911 B2

Mar. 21, 2006

REJECTIONS

R1: Claim 42 stands rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter.

R2: 22 to 42 stand rejected under 35 U.S.C. 103(a) for being obvious over Shaughnessy.

Groups of Claims:

Claims will be discussed in the order of the rejections and arguments. See 37 CFR § 1.41.37(c)(vii). See *also In re McDaniel*, 293 F.3d 1379, 1383 (Fed. Cir. 2002) (“If the brief fails to meet either requirement [of 37 CFR § 1.192(c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.”).

Appellant contends that claim 42 is statutory, for relating to a physical device. Appellant further contends that the claimed subject matter is not rendered obvious by Shaughnessy for failure of Shaughnessy to teach all of the claimed limitations. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this opinion. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We affirm.

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. §§ 101 and 103(a). The first issue turns on whether the outputting of a report is necessary to render claim 42 statutory. The second issue turns on whether Shaughnessy supports a conclusion that all of the claimed limitations are obvious over the prior art.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Appellant has invented a system and method for generating reports in a Web based system which can be easily updated. (Spec., p. 1, middle). Appellant uses a set of software modules to first parse an XML definition file to define from where the data shall be collected and how it shall be reported. (¶ 18, 19). The method/system, called ReportGate (*Id.*) permits program modules to act within its framework to accept data from databases and organize it into tables suitable for reports. (¶ 20 – 28). Final reports are based on the XML configuration files. (¶ 35).

2. Shaughnessy teaches a system and method for generating reports in a Web environment. (Col. 2, l. 55). A report specification 36 directs processing modules in a report rendering engine 38 to compile data from various data sources (34) and to update the report when the data changes. (Col. 2, l. 14). (Fig. 1). The report specification contains a data structure from which various sub specifications are extracted, and which specify where the data is to be found, how it is to be visually represented, which report templates are to be used and in what format the report is to be rendered.

PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"It is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1732 (2007).

The analysis begins with an interpretation of the claims: "[b]oth anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims

The second step in the analyses requires a comparison of the properly construed claim to the prior art.” *Medichem S.A. v. Rolabo S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.” Our reviewing court further states that “the words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The “ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Id.* at 1313.

Laws of nature, physical phenomena and abstract ideas are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

The test for statutory subject matter is whether the claimed subject matter is directed to a “practical application,” i.e., whether it is applied to produce “a useful, concrete and tangible result.” *See State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998).

“Therefore we also conclude that the “useful, concrete and tangible result” inquiry is inadequate and reaffirm that the machine-or-transformation test outlines by the Supreme Court is the proper test to apply.” [Footnote: “As a result, those portions of our opinions in State Street and AT&T relying solely on a “useful, concrete and tangible result” analysis should no longer be relied on.” *In re Bilski*, Case 2007-1130, page 20, (Fed. Cir, Oct 30, 2008).

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejections of Appellant's claims under 35 U.S.C. §§ 101 and 103. The prima facie case is presented on pages 3 to 8 of the Examiner's Answer. In opposition, Appellant presents a number of arguments.

*Arguments with respect to the rejection
of claim 42
under 35 U.S.C. § 101*

The first argument addresses the issue of whether the method of claim 42 comprises statutory subject matter under 35 U.S.C. § 101. The Examiner explains the rejection as, “[t]he final step of the claim, ‘organizing’, does not output a report; it merely prepares it for output. Thus, the invention claimed by claim 42 does not produce a tangible result.” (Ans., p. 9, middle).

Appellant argues that the parsing step, as well as the extracting step, produce a tangible result, and thus the claim should be considered statutory. (Br., p. 7).

We believe the Examiner has erred in rejecting this claim. The Examiner's argument centers on the test for being statutory by producing “a useful, concrete and tangible result” as indicated in *State St. Bank & Trust Co. v. Signature Fin. Group, Inc.* (See citation above). In accordance with *In re Bilski* (cited above) the arguments of *State Street* will no longer be considered dispositive of this issue. (See the comments on *State Street* in the Legal Principles section above.)

In the analysis of *In re Nuijten*, 500 F.3d 1346 (Fed. Cir., 2007), the Federal Circuit considers the four statutory classes for a signal, and bases the determination of statutory subject matter on that basis. It has been the practice for a number of years that a “Beauregard Claim” of this nature be considered statutory at the USPTO as a product claim. (MPEP 2105.01, I). Though not finally adjudicated, this practice is not inconsistent with *In re Nuijten*. (*Ibid.*). Further, the instant claim presents a number of software components, such as the claimed logic processing module, configuration file processing module, data organization module, and data display organization module, that are embodied upon a computer readable medium. This combination has been found statutory under the teachings of *In re Lowry*, 32 F.3d 1579 (Fed. Cir., 1994). In view of the totality of these precedents, we decline to support the rejection under 35 U.S.C. § 101.

*Arguments with respect to the rejection
of claims 22 to 42
under 35 U.S.C. § 103*

Appellant contends that the Examiner erred in rejecting claims 22 to 42 for being obvious over Shaughnessy for a number of reasons.

Appellant first argues that Shaughnessy fails to teach or suggest “the claimed logical interrelationships that connect the claimed software modules with one another.” (Br. 9, middle). The logical relationships are explained to be the parsing, the extracting, and the organizing of the data according to a definition, each by a certain one of the processing modules. The Examiner argues that the method of breaking down the program into modules would

be a concept well known to one of ordinary skill in the art. For the reasons expressed by the Examiner, (Ans., p. 10, bottom) we decline to see error in the rejection on this point. Shaughnessy's processing modules perform the equivalents of parsing the report specification and data structure to sub-specifications (col. 2, l. 48), extracting data report data from information sources (col. 2, l. 55; col. 4, l. 3), and organizing the data according to templates (col. 3, top). We agree with the Examiner that it would be obvious to assign out the processing to modules as claimed.

Appellant contends that Shaughnessy does not teach or suggest the parsing of the configuration file as claimed. (Br., p. 10, bottom). As discussed above, we do not find error in the Examiner's rejection. The Examiner's Answer discusses the actual use of the word "parsing" as commonly understood. (Ans., p. 11, bottom). We find the common meaning of the word, absent any special and express definition in the Specification, to be suggested by Shaughnessy. (See *Phillips v. AWH Corp.*, cited above).

Appellant contends that Shaughnessy does not teach that the parsing being "performed by the configuration file processing module in response to being called by the logic processing module...". (Br., p. 13, middle). In view of the logic expressed above, we do not find it erroneous for the Examiner to maintain the rejection over Shaughnessy. In the paragraph starting in column 2, line 48, and following, the reference teaches processing to generate the extraction (read on parsing) from the data structure of the same elements of data as claimed – the specifications of which data to accumulate, how to organize the data, which templates to use to display the

data in a report. The naming of a module by certain nomenclature, for example “configuration file processing module”, does not render the module structurally or functionally unobvious. We decline to find error in the Examiner’s rejection.

For the same reasons, we decline to find error in the Examiner’s reading of the extraction of report data performed by a data organization module. (Br., p. 14, middle). The reference performs the same function in the same manner as claimed. (Col. 3, line 63).

Appellant argues that the retrieval of “external data” from external sources by Shaughnessy cannot be read on the claimed retrieval of program code. (Br., p. 21, middle). We decline to find error in view of the Examiner’s pointing out that the retrieved data in Shaughnessy is in the form of stored procedures, i.e., program code. (Ans., p. 15, middle).

Other arguments concerning the execution parameters of an SQL statement (Br., p. 26, top) and nested tables (Br., p. 27) are considered appropriately answered by the Examiner’s Answer.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claim 42 under 35 U.S.C. § 101. However, we further conclude that the Examiner did not err in rejecting claims 22 to 42 under 35 U.S.C. § 103.

Appeal 2008-1213
Application 10/463,287

DECISION

The Examiner's rejection of claim 42 under 35 U.S.C. § 101 for being non-statutory is reversed. The Examiner's rejection of claims 22 to 42 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc

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